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| 10/046,216 | 01/16/2002 | Bert Peeters | 111353 | 4400 |

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| EXAMINER | |
|---|---|
| ROHWER, JACOB P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/046,216 | PEETERS, BERT | |
| | Examiner | Art Unit | |
| | Jacob P. Rohwer | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-4, 6, 8-11, 13-15, and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No 2003/0074312 to White, in view of US Patent Application Publication No 2003/0004886 to Chandar et al.

Regarding claim 1, White discloses a method of performing a billing process for the copies or prints produced by a customer of a printing system **(Fig 1)**, the printing system comprising a memory **(Fig 1 #10)** storing product usage data indicating a measurement of the actual use of the printing system, the method comprising:

a) in the printing system, accessing the memory to retrieve said product usage data; **(Fig 3 #300, Para [0027] Lin 1-5 discloses retrieving account balance. However Para [0025] Lin 8-9 discloses how the billing manager determines what a specific user printed at a particular time. It is inherent that within the printing device there is some memory or buffer to temporarily store the product usage of the terminal device.)**

b) in the printing system, calculating billing data using the retrieved product usage data; **(Fig 2 #160, Para [0024] Lin 3-5)**

c) in the printing system, presenting a bill to the customer based on said billing data; **(Fig 2 #160, Para [0024] Lin 5-11])**

d) in the printing system, receiving authorization information indicating whether the customer authorizes the billing data; **(Fig 2 #170 Para [0024] Lin 9-15)** and

e) if said authorization information indicates that the customer has authorized the billing data, sending a message from the printing system to a billing service over a network, the message including information indicating the authorized billing data. **(Fig 2 #200, Para [0025] Lin 5-7 and 11-13)**

Although White only discloses that the billing manager is *connected* to printer device(s), **(Para [0017] Lin 14-15)** White does not expressly disclose that in the system, the billing manager retrieves the product usage data and calculates billing data using the product usage data, *without communicating over a network.*

However, Chandar discloses a public access system, including a resource tracker that stores and calculates a cost associated with usage without communicating over a network. **(Fig 1 #44 and #72, Para [0022] 23, as disclosed in Fig 1, the Resource Tracker and Cost Calculator are located locally in the work station, so that the steps of accessing usage data and calculating a cost are done without the use of the Network Communication Link and Internet as shown in Fig 1 #32 and #33)**

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The Chandar and White Publications are combinable because they are from the same field of endeavor relating to billing customers relating to using a printing function of a printing device.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the local usage data tracker and cost calculator as specified in the Chandar Publication in order to present the billing data and receive payment as specified in the White Publication.

The suggestion/motivation for doing so would have been to provide for easy storage of resource usage, according to an individual workstation, so that a correct bill can be generated and presented to a user for payment.

Therefore, it would have been obvious to combine the Chandar and White Publications in order to obtain the invention as specified in claim 1.

Regarding claim 2, the combination further discloses the method of claim 1, wherein the steps of presenting a bill to the customer and receiving authorization information from the customer are performed without communication over a network. **(White, Fig 2 #170 Para [0024] Lin 9-15, and as specified in the rejection of claim 1 above, White discloses the steps c and d, and in combination with Chandar, who discloses providing steps a and b without communication over a network, it is shown that steps c and d, according to White and Chandar, would also be performed without communicating over a network.)**

Regarding claim 3, the combination further discloses in White the method of claim 1, wherein the step of receiving authorization information further comprises in response to an absence of user input, generating default authorization input within the printing system. **(Para [0024] Lin 17-18 specifically discloses that if the user does not accept the charges, then access to the print system is denied.)**

Regarding claim 4, the combination further discloses in White the method of claim 1 wherein said product usage data indicating a measurement of the actual use of the printing system is a count value **(Para [0026] Lin 1-2, a measured "token" value is determined based on the printing operation and number of copies)** indicating the number of copies or prints **(Para [0025] Lin 9 discloses calculating a price from a number of sheets)** produced by the customer of the printing system in a given period of time. **(Para [0029] Lin 2-4)**

Regarding claim 6, the combination further discloses in White the method of claim 1, wherein the step of calculating the billing data is initiated by the customer. **(Fig 2 #140, discloses the customer sends a print request, and as a response the billing information is displayed to the user, see rejection of claim 1)**

Regarding claim 8, the combination further discloses in White the method of claim 1, wherein said message is sent from the printing system to the billing service via the Internet. **(Para [0018] Lin 5-6)**

Regarding claim 9, the combination further discloses in White the method of claim 8, wherein said message is an electronic mail message. **(Para [0020] Lin 12 discloses wireless access to a network. It is inherently known in the art that messages or notifications, such as the displaying of billing information, sent through a wireless network are electronic message.)**

Regarding claim 10, the combination further discloses in White the method of claim 1, wherein said message includes electronic banking data authorizing the billing service to debit from the customer's account. **(Fig 4 #430, Para [0029] Lin 26-27)**

Regarding claim 11, the combination further discloses in White the method of claim 1, further comprising:

a) in the printing system, receiving user input from the customer indicating a password, **(Fig 2 #120, Para [0021] Lin 11 discloses a digital signature)**

b) wherein the step of sending said message from the printing system to a billing service is performed only if the correct password has been entered by the customer. **(Fig 3 #130)**

Regarding claim 13, please see rejection of claim 1. Furthermore, the method of claim 1 is performed by the system of claim 13. Additionally, it is inherent that a buffer or temporary memory storing product usage data is included in the printing device **(see claim 1 rejection)**, a billing control unit for accessing the memory **(Fig 2 #4)**, a user interface **(Fig 1 #14, Para [0016] Lin 3-5),** and a message-sending unit. **(Fig 1 #4, Para [0025] Lin 5-8 discloses sending billing information from the billing manager to the billing software.)**

Regarding claim 14, the combination further discloses in Chandar the printing system of claim 13, wherein the user interface message delivery subsystem comprises a user interface unit integrated with the printing system that interfaces with a user without communicating over a network. **(Fig 1 #40)**

Regarding claim 15, which is dependent upon claim 14, please see rejections of claims 4 and 13 above. Furthermore, the method of claim 4 is performed by the system of claim 15.

Regarding claim 18, which is dependent upon claim 13, please see rejections of claims 8 and 13 above. Furthermore, the method of claim 8 is performed by the system of claim 18. **(White, Para [0020] Lin 14)**

Regarding claim 19, which is dependent upon claim 18, White further discloses the said circuitry includes a LAN interface unit. **(White, Para [0020] Lin 14)**

**Claims 5 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of White and Chandar as specified in claims 1 and 13 above, further in view of US Patent Application Publication No 2002/0069168 to Lee et al.

Regarding claim 5, the combination of White and Chandar discloses the method of claim 4.

The combination does not expressly disclose the method of claim 4, receiving user input from the customer indicating the said period of time.

However, Lee discloses a business method where a user defines a billing period for accessing billing information in regard to a specified account. **(Para [0029] Lin 11-13)**

The Lee Publication and the combination of White and Chandar are combinable because they are from the same field of endeavor relating to billing customers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the user defined billing period as specified in the Lee Publication in order to calculate billing data as specified in the combination of White and Chandar.

The suggestion/motivation for doing so would have been to allow the user to effectively control an account budget in order to accommodate personal convenience or financial situations.

Therefore, it would have been obvious to combine the Lee Publication with the combination of White and Chandar in order to obtain the invention as specified in claim 5.

Regarding claim 16, which is dependent upon claim 15, please see rejections of claims 5 and 15 above. Furthermore, the method of claim 5 is performed by the system of claim 16. Additionally, Lee discloses a user interface unit through which the user is able to access the billing information and enter the period of time. **(Fig 1 Personal Computer and Internet)**

**Claims 7 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of White and Chandar as specified in claims 1 and 13 above, in view of commonly known art at the time of the invention.

Regarding claim 7, the combination of White and Chandar discloses the method of claim 1.

The combination does not expressly disclose the method of claim 1 wherein said message is sent from the printing system to the billing service via a phone line.

However, White discloses communication between billing system manager and billing system software occurs through the Internet. **(Para [0025] Lin 11-13)**

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use a phone line in order to send the message from the printing system to the

billing service. Furthermore, it is very common that Internet connections are made through phone lines.

The suggestion/motivation for doing so would have been to allow the printing device to conveniently and quickly access the billing service through the Internet at a location that currently has a phone line installed.

Regarding claim 17, which is dependent upon claim 13, please see rejections of claims 7 and 13 above. Furthermore, the method of claim 7 is performed by the system of claim 13.

**Claims 12 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of White and Chandar as specified in claims 1 and 13 above, in view of US Patent Application Publication No 2003/0149661 to Mitchell et al.

Regarding claim 12, the combination of White and Chandar discloses the method of claim 1,

b) wherein the step of sending said message from the printing system to the billing service is performed only if the authentication means has revealed that the billing data is authorized by the correct person.

The combination does not expressly disclose the method of claim 1 further comprising:

a) in the printing system, performing a fingerprint identification as the authenticating means to ensure that the billing data is authorized by the correct person.

However, Mitchell discloses a method for authenticating financial transactions using a biological identifier such as a fingerprint. **(Fig 2)**

The Mitchell Publication and the combination of White and Chandar are combinable because they are from the same field of endeavor relating to authenticating customers in order to secure financial transactions.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the user the finger print identification as specified in the Mitchell Publication in order to authenticate the customer as specified in the combination of White and Chandar.

The suggestion/motivation for doing so would have been to provide a complete biological identification as an improvement to a password or PIN, which are both capable of being misused or stolen. **(Mitchell Para [0003] and [0004])**

Therefore, it would have been obvious to combine the Mitchell Publication with the combination of White and Chandar in order to obtain the invention as specified in claim 12.

Regarding claim 20, which is dependent upon claim 13, please see rejections of claims 12 and 13 above. Furthermore, the method of claim 12 is performed by the system of claim 20. Mitchell discloses a finger print identification unit in **Fig 1**.

***Response to Arguments***

Applicant's arguments with respect to independent claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection. The Chandar reference has been found to access usage data and calculate billing information for a workstation without the use of network communication. Furthermore, US Paten Application Publication No 2003/0055876 has been cited for applicant to further disclose

that self-service kiosks, can track usage data and receive authorization from a user for billing a certain amount, without the use of network communication.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JR
7/24/06

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